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09/478,051	01/15/2000	MICHAEL J. PICCIALLO	P-22425-B-US	1136

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EXAMINER

KUCAB, JAMIE R

ART UNIT	PAPER NUMBER
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3621

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/478,051	Applicant(s) PICCIALLO, MICHAEL J.	
	Examiner JAMIE KUCAB	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75,77-85,87,99,101-108 and 110-113 is/are pending in the application.
- 4a) Of the above claim(s) 111 and 112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75,77-85,87,99,101-108,110 and 113 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination ("RCE") under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 16, 2009 has been entered.

Acknowledgements

2. In accordance with the RCE above, claims 75, 77-85, 87, 99, 101-108, and 110-113 are currently pending.
3. Claims 111 and 112 are withdrawn from consideration.
4. Claims 75, 77-85, 87, 99, 101-108, 110, and 113 are examined below.
5. This Office action is given Paper No. 20100215 for reference purposes only.

Priority

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. §119(e) or under 35 U.S.C. §§ 120, 121, or 365(c) is acknowledged. Applicant has not

complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §120 as follows:

7. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. §112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

8. The disclosure of the prior-filed application, Application No. 08/585173, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. 08/585173 fails to provide the necessary support for such limitations as “entered by said fund depositor with a personal computer”, “supplying to said fund depositor through a CRT output device...”, and “wherein said fund depositor account and said third party account communicate through an external bank, credit card or atm network” of claim 75, nor does the prior-filed application provide support for similar limitations in the remaining independent claims (99 and 113).

Restriction

9. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 75, 77-85, 87, 99, 101-108, 110, and 113 drawn to funds transfer, classified in class 705, subclass 44.

- II. Claims 111 and 112, drawn to financial computers, classified in class 705, subclass 42.

10. Newly submitted claims 111 and 112 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

11. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as processing periodic funds transfers for accounts not linked to a magnetic stripe card.

12. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

13. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 111 and 112 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112, First Paragraph

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 75, 77-85, 87, 99, 101-108, 110, and 113 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The following limitations were not previously disclosed:

- a. “programming with said personal computer a periodic and automatic transfer of funds into said third party account from said fund depositor account” (claim 75),
- b. “supplying to said fund depositor through a CRT or LCD output device said information stored on fund transferees and corresponding payment amounts for said third party” (claim 75),
- c. “supplying to said fund depositor through a CRT or LCD output device said stored information on fund transferees and corresponding payment amounts for said third party account” (claim 99), and
- d. “supplying to said fund depositor through a CRT or LCD output device information stored on fund transferees and corresponding payment amounts for said third party account” (claim 113).

Regarding item a. above, Applicant discloses automating periodic transfers of funds at pg. 19 lines 9-14. Applicant also discloses that certain actions including third party account creation can be performed at a home PC at pg. 18 line 24 - pg. 19 line 4. However, Applicant does not disclose that the periodic automatic transfers of funds are programmed from a PC. Regarding items b. - d. above, Applicant does disclose supplying to the fund depositor an itemized statement via paper (pg. 17 line 27 - pg. 18 line 2) or email (pg. 15 lines 11-19). However, Applicant does not disclose supplying this information via CRT or LCD. Further, it is the Examiner’s position that supplying information via CRT or LCD is not inherently disclosed, as an emailed itemized statement could also be read on a plasma screen.

Claim Rejections - 35 USC § 112, Second Paragraph

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 75, 77-85, 87, 99, 101-108, 110, and 113 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

18. Regarding claims 75, 99, and 113, Applicant's recitation "fund transferees" would have been unclear to a person having ordinary skill in the art at the time of the invention. As used by Applicant in the specification, this term refers to the third party recipient of a funds transfer (pg. 2, lines 15-17). However, such an interpretation does not make sense here. For the purpose of comparison with the prior art, the Examiner is interpreting "fund transferees" to be --payees--. Support for such an interpretation can be found at least at pg. 4 lines 8-9 of the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 75, 77-83, 85, 87, 99, 101-107, 110, and 113, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming (US Patent 5,953,710) in view of Langhans et al. (US Patent 4,837,422, hereafter “Langhans”).

21. Regarding claims 75, 99, and 113, Fleming discloses a computer-based method for transferring funds from a bank or credit card account of a fund depositor to third party recipients, comprising:

- a. creating a third party account (“a child’s credit card account,” Abstract) with a bank linked to a bank or credit card account of a fund depositor (“linked to a parent’s credit or debit card account,” Abstract);
- b. encoding a magnetic card (“Children’s Credit Card 4,” Fig. 1; the card has a magnetic strip, C16 L53-55) linked to said third party account (“linked to a parent’s credit or debit card account,” Abstract) with third party account information permitting cash withdrawals or fund transfers as payments for goods or services (“The children’s credit card system is used for purchases in exactly the same way as other credit cards,” C16 L41-42);
- c. issuing said magnetic card to a third party recipient of said fund depositor (“Credit and debit cards are issued to individuals or entities by banks and others,” C1 L15-16);
- d. storing information on fund transferees and corresponding payment amounts for goods and services obtained using said magnetic card linked to said

third party account ("The expenditure is recorded by creating a new debit transaction record in the database, C8 L35-37);

e. supplying to said fund depositor through a CRT or LCD output device said information stored on fund transferees and corresponding payment amounts for said third party account ("Other systems that allow the customer to input and receive information, automated teller machines and personal computer systems, also may be used in this invention." C9 L60-63);

f. wherein said fund depositor account and said third party account communicate through an external bank, credit card or atm network (see Fig. 3, which shows that both the parent and child credit card accounts communicate through an external bank network, "Telecommunications Link 12(a)")

22. However, although Fleming discloses a periodic and automatic transfer of funds into the third party account from the fund depositor account ("These requests may be automated at the request of the parent," C14 L50-51), Fleming fails to explicitly disclose that the account and periodic transfers are created using a personal computer.

23. Langhans teaches using information entered by said fund depositor with a personal computer and programming with said personal computer a periodic and automatic transfer of funds into said third party account from said fund depositor account ("These terminals could be used by bank employees configuring the account, or be used directly by a corporate customer to provide the configuration," C6 L4-6).

24. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Fleming to include the using information entered

by said fund depositor with a personal computer and programming with said personal computer a periodic and automatic transfer of funds into said third party account from said fund depositor account of Langhans in order to achieve the predictable result of allowing the end user of the accounts convenient access to create and configure accounts without needing to interact with a bank employee.

25. Regarding claims 77 and 101, Fleming further discloses wherein said bank or credit card account for said fund depositor is a new account ("create a new parent's account number," C6 L3-4).

26. Regarding claims 78-81, 87, 102-105, and 110 Fleming fails to explicitly disclose the steps of:

- a. limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using information entered by said fund depositor with a personal computer;
- b. verifying a fund transfer requested by said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased;
- c. wherein said goods or services comprise books, computer software, food, lodging or entertainment;
- d. wherein said limit is a periodic limit; and
- e. wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal of cash or spending on alcohol or tobacco.

27. However, Langhans teaches:

- a. limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using information entered by said fund depositor with a personal computer ("The present invention also allows a company to group merchant category codes in order to limit purchases to those merchant types which would be needed by a particular department or individual." C2 L37-40);
- b. verifying a fund transfer requested by said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased ("A test 126 determines whether the Standard Industrial Classification (SIC) code of the merchant is acceptable for the account. If it is not, the request will be declined." C7 L55-58);
- c. wherein said goods or services comprise books, computer software, food, lodging or entertainment ("a salesperson could be allowed a velocity checking limit for the category of hotels at a high frequency level, while an accounting clerk with no reason to travel could be allocated a lower velocity level, or allocated no authorization for hotels at all." C2 L12-17);
- d. wherein said limit is a periodic limit ("Test 138 allows a spending limit to be applied over a company-defined cycle, such as a monthly cycle or other billing cycle." C8 L9-11); and
- e. wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal

of cash or spending on alcohol or tobacco ("control cash advances," C13 L27-28).

28. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Fleming to include the limiting step, verifying step, merchant categories, periodic limit, and controlling cash advances of Langhans in order to achieve the predictable result of giving the user greater flexibility in the control of the third party's spending.

29. Regarding claims 82 and 106, Fleming further discloses wherein said stored information on fund transferees and corresponding payment amounts for said third party account is automatically supplied to said fund depositor ("Fig. 2a depicts a parent statement list 56 which is used to generate a monthly statement for the parent's credit card." C7 L25-26).

30. Regarding claims 83 and 107, Fleming further discloses wherein said supplying step is performed periodically ("Fig. 2a depicts a parent statement list 56 which is used to generate a monthly statement for the parent's credit card." C7 L25-26).

31. Regarding claim 85, Fleming further discloses wherein said funds are transferred weekly or monthly ("When the parent selected allowances, they would be prompted by the Bank Telecom Interface 62 to enter the allowance amount and the periodic interval of the allowance, such as weekly," C14 L55-58).

32. Claims 84 and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleming/Langhans in view of Applicant-Admitted Prior Art.

33. Fleming/Langhans discloses all the elements of the claimed invention. But Fleming/Langhans fails to explicitly disclose wherein said stored information is supplied via e-mail.

34. However, it is Applicant-Admitted Prior Art that a well known method for exchanging data over the internet is via electronic mail (see Office action mailed September 6, 2007).

35. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Fleming/Langhans to include the e-mail step of Applicant-Admitted Prior Art because all the claimed steps were known in the prior art and one skilled in the art could have combined the steps as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Double Patenting

36. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

37. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

38. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

39. Claims 75, 77-85, 87, 99, 101-108, 110, and 113 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,653,595. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ merely in terminology. Those limitations not explicitly disclosed in the claims of the '595 patent would be obvious in view of the claims of the '595 patent and either Langhans or Fleming.

Response to Arguments

40. Applicant's arguments filed December 16, 2009 have been fully considered, but they are only partially persuasive.

41. Applicant's cancellation of claim 98 renders the §101 rejections of this claim moot. Therefore, the §101 rejection of claim 98 is withdrawn.

42. Regarding the §112, 1st paragraph rejection of claims 75, 77-85, 87, 99, 101-108, and 110, these rejections are withdrawn. The previous rejection was based on an overly narrow interpretation of the limitation in question. The Examiner had previously interpreted "wherein said fund depositor account and said third party account communicate through an external bank, credit card or atm network" as requiring that the two accounts communicate *with each other* through such a network. See Final Rejection mailed August 13, 2009, pg. 7. After further consideration, this limitation merely requires that each of the accounts perform some communication via an external bank, credit card or atm network. Based on this revised interpretation, Applicant has support for this limitation as argued at pgs. 10-11. However, the Examiner must respectfully disagree with Applicant's assertion that such support is found at least as early as April 16, 1996. Remarks, pg. 11. No such support can be found in this CIP ancestor application 08/585,173 filed April 16, 1996.

43. Applicant's arguments regarding the §103 rejections of the claims are moot in view of the new grounds of rejection.

Conclusion

44. Suggestions or examples of claim language provided by the Examiner in this Office Action are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that the claim is “allowed,” exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has not been addressed with respect to other aspects of patentability (e.g. §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

45. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

46. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

47. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamie Kucab/
Examiner, Art Unit 3621